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DF

Attorney's Docket No. 003022.P011

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Vance C. Bjorn

Application No.: 09/153,782

Filed: September 16, 1998

For: A Configurable Multi-Function
Touchpad Device

Examiner: Yon Jung Couso

Art Unit: 2625

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF TRANSMITTAL

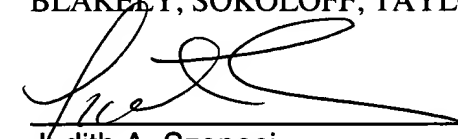
Sir:

Enclosed for consideration is Appellant's Appeal Brief pursuant to C.F.R. §1.192 for the above-referenced case. This Brief is submitted in response to the Final Office Action mailed from the Examiner on August 6, 2004.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 2/4, 2005



Judith A. Szepesi
Reg. No. 39,393

12400 Wilshire Blvd.
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Los Angeles, CA 90025-1026
(408) 720-8300

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on Feb. 4, 2005

(Date of Deposit)

Tina Wainright

(Typed or printed name of person mailing correspondence)


(Signature of person mailing correspondence)

**FEE TRANSMITTAL FOR FY 2005**

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

TOTAL AMOUNT OF PAYMENT (\$) 500.00**Complete if Known:**

Application No. 09/153,782
Filing Date September 16, 1998
First Named Inventor Vance C. Bjorn
Examiner Name Yon Jung Couso
Art Unit 2625
Attorney Docket No. 003022.P011

Applicant claims small entity status. See 37 CFR 1.27.

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify)

☒ Deposit Account

Deposit Account Number : 02-2666

Deposit Account Name: _____

☒ The Director is Authorized to do the following with respect to the above-identified Deposit Account:

☐ Charge fee(s) indicated below.

☒ Charge any additional fee(s) or underpayment of fee(s) during the pendency of this application.

☐ Charge fee(s) indicated below except for the filing fee

☒ Credit any overpayments.

☒ Any concurrent or future reply that requires a petition for extension of time should be treated as incorporating an appropriate petition for extension of time and all required fees should be charged.

Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Large Entity		Small Entity		Fee Description		Fees Paid (\$)
Code	Fee (\$)	Code	Fee (\$)			
1011	300	2011	150	Utility application filing fee	} 1,000/500	_____
1111	500	2111	250	Utility search fee		_____
1311	200	2311	100	Utility examination fee		_____
1012	200	2012	100	Design application filing fee	} 430/215	_____
1112	100	2112	50	Design search fee		_____
1312	130	2312	65	Design examination fee		_____
1013	200	2013	100	Plant filing fee	} 660/330	_____
1113	300	2113	150	Plant search fee		_____
1313	160	2313	80	Plant examination fee		_____
1004	300	2004	150	Reissue filing fee	} 1,400/700	_____
1114	500	2114	250	Reissue search fee		_____
1314	600	2314	300	Reissue examination fee		_____
1005	200	2005	100	Provisional application filing fee		_____
SUBTOTAL (1)						\$ <u>0.00</u>

2. EXCESS CLAIM FEES

		<u>Extra Claims</u>	<u>Fee from below</u>	<u>Fees Paid (\$)</u>
Total Claims	_____ - 20 or HP = _____		X \$50.00 = _____	
HP = highest number of total claims paid for, if greater than 20				
Independent Claims	_____ - 3 or HP = _____		X \$200.00 = _____	
HP = highest number of independent claims paid for, if greater than 3				
Multiple Dependent Claims			_____ = _____	

<u>Large Entity</u>		<u>Small Entity</u>		<u>Fee Description</u>
<u>Fee Code</u>	<u>Fee (\$)</u>	<u>Fee Code</u>	<u>Fee (\$)</u>	
1202	50	2202	25	Each claim over 20
1201	200	2201	100	Each independent claim over 3
1203	360	2203	180	Multiple dependent claims, if not paid
1204	200	2204	100	Reissue: each claim over 20 and more than in the original patent
1205	50	2205	25	Reissue: each independent claim more than in the original patent

SUBTOTAL (2) \$ 0.00

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each add'l 50 or fraction thereof</u>	<u>Fee from below</u>	<u>Fees paid (\$)</u>
_____	- 100 = _____	/ 50 = _____ (round up to whole number)	X \$250.00	_____

<u>Large Entity</u>		<u>Small Entity</u>		<u>Fee Description</u>
<u>Fee Code</u>	<u>Fee (\$)</u>	<u>Fee Code</u>	<u>Fee (\$)</u>	
1081	250	2081	125	Utility
1082	250	2082	125	Design
1083	250	2083	125	Plant
1084	250	2084	125	Reissue

SUBTOTAL (3) \$ 0.00

FEE CALCULATION (continued)**4. OTHER FEE(S)**

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late filing fee or oath	1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	1053	130	1053	130	Non-English specification	1812	2,520	1812	2,520	For filing a request for ex parte reexamination	1813	8,800	1813	8,800	Request for inter parties reexamination	1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	1251	120	2251	60	Extension for reply within first month	1252	450	2252	225	Extension for reply within second month	1253	1,020	2253	510	Extension for reply within third month	1254	1,590	2254	795	Extension for reply within fourth month	1255	2,160	2255	1,080	Extension for reply within fifth month	1401	500	2401	250	Notice of Appeal	1402	500	2402	250	Filing a brief in support of an appeal	1403	1,000	2403	500	Request for oral hearing	1451	1,510	1451	1,510	Petition to institute a public use proceeding	1452	500	2452	250	Petition to revive - unavoidable	1453	1,500	2453	750	Petition to revive - unintentional	1501	1,400	2501	700	Utility issue fee (or reissue)	1502	800	2502	400	Design issue fee	1503	1100	2503	550	Plant issue fee	1462	400	1462	400	Petitions to the Commissioner (CFR 1.17(f) Group I)	1463	200	1463	200	Petitions to the Commissioner (CFR 1.17(g) Group II)	1464	130	1464	130	Petitions to the Commissioner (CFR 1.17(h) Group III)	1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	1806	180	1806	180	Submission of Information Disclosure Stmt	8021	40	8021	40	Recording each patent assignment per property (times number of properties)	1809	790	2809	395	For filing a submission after final rejection (see 37 CFR 1.129(a))	1814	130	2814	65	Statutory Disclaimer	1810	790	2810	395	For each additional invention to be examined (see 37 CFR 1.129(b))	1801	790	2801	395	Request for Continued Examination (RCE)	1802	900	1802	900	Request for expedited examination of a design application	1504	300	1504	300	Publication fee for early, voluntary, or normal pub.	1505	300	1505	300	Publication fee for republication	1803	130	1803	130	Request for voluntary publication or republication	1808	130	1808	130	Processing fee under 37 CFR 1.17(i) (except provisionals)	1454	1,370	1454	1,370	Acceptance of unintentionally delayed claim for priority	
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*Reduced by Basic Filing Fee Paid

SUBMITTED BY:Typed or Printed Name: Judith A. SzepesiSignature: Date: 2/4/05Reg. Number: 39,393Telephone Number: 408-720-8300

Send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450



Atty Docket No. 003022.P011

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Vance C. Bjorn

Application No: 09/153,782

Filing Date: September 16, 1998

For: A Configurable Multi-Function
Touchpad Device

Examiner: Yon Jung Couso

Art Unit: 2625

Confirm. No. 6034

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37(a)

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group 2625, dated August 6, 2004, which finally rejected Claims 1-31 in the above-identified application. This Appeal Brief is hereby submitted pursuant to 37 C.F.R. § 41.37(a).

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop Appeal Brief- Patents, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on Feb. 4, 2005
Date of Deposit

Tina Wainright

Name of Person Mailing Correspondence

[Signature]

Signature

2-4-05

Date

I. REAL PARTY IN INTEREST

The real parties in interest are the assignees of the full interest in the invention, DigitalPersona, Inc., of 720 Bay Road, Suite 100, Redwood City, CA 94063

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF THE CLAIMS

Claims 1-31 are pending in the application and were finally rejected in an Office Action mailed August 6, 2004. Claims 1-5, 13, 15-17, 23, 24, 30, and 31 were finally rejected. Claims 6-12, 14, 18-22, and 25-29 were objected to. Claims 1-5, 13, 15-17, 23, 24, 30, and 31 are the subject of this appeal. A copy of Claims 1-31 as they stand are set forth in Appendix A.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action mailed August 6, 2004, rejecting claims 1-5, 13, 15-17, 23, 24, 30, and 31 and objecting to claims 6-12, 14, 18-22, and 25-29, Appellant filed an Amendment After Final under 37 C.F.R. 1.116 on November 22, 2004 and a Notice of Appeal on December 6, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's invention as claimed in claim 1 is a touchpad device configurable to be a pointer control device and a fingerprint recognition device based on parameters associated with image data. (Specification, page 8, lines 10-13). The touchpad device includes a detection array having a detection surface configured to receive a fingerprint image. (Specification, page 10, lines 8-10). Additionally, a processing device is provided to receive image fingerprint image or data from the detection array. (Specification, page 10, lines 10-12). The processing device configures the touchpad device to operate as the pointer control device to move a cursor or the fingerprint

recognition device based upon parameters associated with the image data. (Specification, page 10, lines 12-15).

Independent claim 15 recites a device that includes means for supplying a fingerprint image to a detection surface of a detection array, and means for processing the fingerprint image supplied to the detection array. (Specification, page 10, lines 8-15).

Claim 23 recites a method of analyzing a fingerprint image to configure the operation of a multi-function device, wherein a fingerprint image is supplied to a detection surface of a detection array. (Specification, page 10, lines 5-7). Select fingerprint parameters associated with the fingerprint image are analyzed. (Specification, page 14, lines 19-21). The multi-function device is configured to operate as the pointer movement control device or the fingerprint recognition device based upon the fingerprint parameters associated with the fingerprint image. (Specification, page 14, lines 14-18).

VI. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

- I. Examiner rejected claims 1, 2, 5, 13, 15-17, 23, 24, 30, and 31 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,392,636 by Ferrari et al.
- II. Examiner rejected claims 3 and 4 under 35 U.S.C. §103(a) as being unpatentable over Ferrari et al in view of U.S. Patent No. 5,732,148 by Keagy et al.

VII. ARGUMENT

- I. Claims 1, 2, 5, 13, 15-17, 23, 24, 30, and 31 are Patentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,392,636 by Ferrari et al.

Ferrari discloses a capacitive touchpad device that can operate first fingerprint recognition device and then as a pointer control device. (Ferrari, col. 4, lines 22-28). When a user first logs onto the computer, a capacitance sensing cell array captures a fingerprint pattern that is used to determine the user is authorized. (Ferrari, col. 4, lines 29-31). Upon user authorization, the array provides screen cursor/pointer control. (Ferrari, col. 4, lines 31-33).

Ferrari does not teach or suggest a touchpad device configurable to be a pointer control device or a fingerprint recognition device based upon the parameters associated with the image data as recited in independent claim 1. Rather, Ferrari's touchpad device

starts out as a fingerprint recognition device during initial log-on, and based on whether the user is authorized, operates as a pointer control device. Accordingly, Ferrari's touchpad device can only operate as a pointer control device after successful log-on; it cannot be configured to be a fingerprint recognition device after log-on based on parameters associated with image data.

The Examiner has equated "parameters associated with the image data" to time. (Office Action dated August 6, 2004, page 2, lines 7-11). Thus, according to the Examiner, Ferrari's touchpad device acts as a fingerprint recognition device and a pointer control device based on time. However, time is not a parameter associated with image data. An image parameter, as defined in the specification, relates to the area, size, location, pattern or format of the image data. (Specification, page 16, lines 1-4; page 16, lines 24-26). The phrase "parameter associated with the image data" is specifically described by the Appellants in the Specification. It is a well-established axiom in patent law that a patentee or Appellant is free to be his or her own lexicographer (MPEP 2173.05(a)). Appellants' use of the phrase "parameters associated with the image data" is defined in the Specification as follows:

As mentioned above, the multi-function touchpad device 100 is configured to operate as a pointer control device or a fingerprint recognition device based upon select parameters associated with a fingerprint image which are reflected in the images or image data supplied to the processing device 105. Accordingly, the processing device 105 analyzes the images or image data, received from the detection array 110, to determine the operational mode of the multi-function touchpad device 100.

(Specification, page 14, lines 14-21). Ferrari does not teach or suggest such a parameter associated with the image data.

Arguendo, even if time can be construed as a parameter based on image data, Ferrari's touchpad device cannot be configured to operate as a fingerprint recognition device based on time, since once the user is successfully authenticated, Ferrari's touchpad device can only operate as a pointer control device. Therefore, Ferrari's device cannot be configured to operate as a fingerprint recognition device based on time or other parameters. Once Ferrari has successfully authenticated the user, the touchpad device is for cursor control only.

Thus, Ferrari does not teach or suggest a device that can be configured to operate as the pointer control device or the fingerprint recognition device based on parameters associated with the image data.

Similarly, claim 15 recites that the “means for processing configures the multi-function device to operate as the pointer movement control device or the fingerprint recognition device based upon parameters associated with the fingerprint image.” As noted above, Ferrari does not teach or suggest configurability based on parameters associated with the fingerprint image.

Similarly, claim 23 recites “configuring the multi-function device to operate as the pointer movement control device or the fingerprint recognition device based upon the fingerprint parameters associated with the fingerprint image.” Ferrari does not teach or suggest configuring the multi-function device based upon fingerprint parameters associated with the fingerprint image.”

Therefore, claims 1, 2, 5, 13, 15-17, 23, 24, 30, and 31 are not anticipated by Ferrari.

II. Claims 3 and 4 are Patentable under 35 U.S.C. §103(a) over Ferrari et al in view of U.S. Patent No. 5,732,148 by Keagy et al.

As discussed above, Ferrari’s touchpad mechanism can operate only as a pointer control device based on whether the user is authorized. Ferrari does not teach or suggest a device that can be configured to operate as a pointer control device or a fingerprint recognition device based on parameters associated with the image data.

Keagy discusses a sheet prism based fingerprint sensor. Keagy does not teach or suggest configuring the function of the touchpad device to pointer control device or fingerprint recognition device at all, nor does Keagy mention parameters associated with the image data. Thus, Keagy does not overcome the shortcomings of Ferrari described above. Therefore, Ferrari and Keagy, either individually or in combination, do not teach or suggest configurability based on parameters associated with image data. Thus, Claims 3 and 4 are not obvious over Ferrari in view of Keagy.

VIII. CONCLUSION

For the reasons stated above, claims 1, 2, 5, 13, 15-17, 23, 24, 30, and 31 are patentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,392,636 by Ferrari et al.

For the reasons stated above, claims 3 and 4 are patentable under 35 U.S.C. §103(a) over Ferrari et al in view of U.S. Patent No. 5,732,148 by Keagy et al.

Appellant respectfully requests that the Board reverse the rejections of the claims 1-5, 13, 15-17, 23, 24, 30, and 31 and direct the Examiner to enter a Notice of Allowance for Claims 1-31.

Fee for Filing a Brief in Support of Appeal

Enclosed is a check in the amount of \$500.00 to cover the fee for filing a brief in support of an appeal as required under 37 C.F.R. § 1.17(c) and 41.20(b)(2).

Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

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Appendix A

1. (Previously Presented) A touchpad device configurable to be a pointer control device and a fingerprint recognition device, the touchpad device comprising:
 - a detection array having a detection surface, wherein the detection surface is configured to receive a fingerprint image;
 - a processing device to receive image data from the detection array, the processing device further to configure the touchpad device to operate as the pointer control device to move a cursor or the fingerprint recognition device based upon parameters associated with the image data.
2. (Original) The touchpad device of claim 1, further comprising a fingerprint platform, wherein the fingerprint platform is configured to supply a fingerprint image to the detection surface of the detection array.
3. (Original) The touchpad device of claim 1, wherein the fingerprint platform comprises a sheet prism.
4. (Original) The touchpad device of claim 3, wherein the sheet prism is configured to focus the fingerprint image onto the detection surface of the detection array.
5. (Original) The apparatus of claim 1, wherein the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image.
6. (Original) The apparatus of claim 5, wherein the touchpad device is configured to operate as a fingerprint recognition device when the area parameter associated with the fingerprint image corresponds to a first area median range.

7. (Original) The apparatus of claim 5, wherein the touchpad device is configured to operate as a pointer control device when the area parameter associated with the fingerprint image corresponds to a second area median range.

8. (Original) The apparatus of claim 1, wherein the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon a pattern parameter associated with the fingerprint images.

9. (Original) The apparatus of claim 8, wherein the touchpad device is configured to operate as a fingerprint recognition device when the pattern parameter associated with the fingerprint image conforms to a first pattern.

10. (Original) The apparatus of claim 9, wherein the first pattern corresponds to a full fingerprint pattern.

11. (Original) The apparatus of claim 8, wherein the touchpad device is configured to operate as a pointer control device when the pattern parameter associated with the fingerprint image conforms to a second pattern.

12. (Original) The apparatus of claim 11, wherein the second pattern corresponds to a finger-tip print pattern.

13. (Original) The apparatus of claim 1, wherein the processing device is configured to translate the position of the fingerprint image on the detection surface into a cursor position on an interface area of a display when the touchpad device operates as a pointer control device.

14. (Original) The apparatus of claim 1, wherein the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon both a pattern parameter and an area parameter associated with the fingerprint image.

15. (Previously Presented) A multi-function device configurable to be a pointer control device and a fingerprint recognition device, the multi-function device comprising:

means for supplying a fingerprint image to a detection surface of a detection array;

means for processing the fingerprint image supplied to the detection array, wherein the means for processing configures the multi-function device to operate as the pointer movement control device or the fingerprint recognition device based upon parameters associated with the fingerprint image.

16. (Previously Presented) The multi-function device of claim 15, wherein the pointer control device controls movement of a cursor on a display screen.

17. (Original) The multi-function device of claim 15, wherein the multi-function device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image.

18. (Original) The multi-function device of claim 17, wherein the multi-function device is configured to operate as a fingerprint recognition device when the area parameter associated with the fingerprint image corresponds to a first area median range

19. (Original) The multi-function device of claim 17, wherein the multi-function device is configured to operate as a pointer control device when the area parameter associated with the fingerprint image corresponds to a second area median range.

20. (Original) The multi-function device of claim 15, wherein the multi-function device is configured to operate as a pointer control device or a fingerprint recognition device based upon a pattern parameter associated with the fingerprint images.

21. (Original) The multi-function device of claim 20, wherein the multi-function device is configured to operate as a pointer control device when the pattern parameter associated with the fingerprint image conforms to an average finger-tip pattern.

22. (Original) The multi-function device of claim 20, wherein the multi-function device is configured to operate as a fingerprint recognition device when the pattern parameter associated with the fingerprint image conforms to an average fingerprint pattern.

23. (Previously Presented) A method of analyzing a fingerprint image to configure the operation of a multi-function device, the multi-function device configurable to be a pointer movement control device and a fingerprint recognition device, the method comprising:

- supplying a fingerprint image to a detection surface of a detection array;
- analyzing select fingerprint parameters associated with the fingerprint image;
- configuring the multi-function device to operate as the pointer movement control device or the fingerprint recognition device based upon the fingerprint parameters associated with the fingerprint image.

24. (Original) The method of claim 23, wherein the multi-function device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image.

25. (Original) The method of claim 24, wherein the multi-function device is configured to operate as a fingerprint recognition device when the area parameter associated with the fingerprint image corresponds to a full fingerprint image.

26. (Original) The method of claim 24, wherein the multi-function device is configured to operate as a pointer control device when the area parameter associated with the fingerprint image corresponds to a finger-tip print image.

27. (Original) The method of claim 23, wherein the multi-function device is configured to operate as a pointer control device or a fingerprint recognition device based upon an pattern parameter associated with the fingerprint images.

28. (Original) The method of claim 27, wherein the multi-function device is configured to operate as a fingerprint recognition device when the pattern parameter associated with the fingerprint image conforms to an average fingerprint pattern.

29. (Original) The method of claim 27, wherein the multi-function device is configured to operate as a pointer control device when the pattern parameter associated with the fingerprint image conforms to an average finger-tip pattern.

30. (Original) The method of claim 23, further comprising:
translating the position of the fingerprint image supplied to the detection surface of the detection array into a cursor position on an interface area of a display when the multi-function device is configured to operate as a pointer control device.

31. (Original) The method of claim 23, further comprising:
performing fingerprint authentication on the fingerprint image supplied to the detection surface of the detection array when the multi-function device is configured to operate as a fingerprint recognition device.